UNITED STATES
PATENT AND
TRADEMARK OFFICE

JAN - 3 2002

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

#17

Savatore J. Arrigo
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P
1300 I Street, W.W.
Washington D.C., 20005

In re Application of	:
Dujon et al.	:
Serial No.: 09/492,697	: DECISION ON PETITION
Filed: 27 January 2000	:
Attorney Case No: 3495.0111-11	:

This is in response to applicants' petition filed 20 August 2001, for review of the restriction requirement set forth 12 February 2001 as Paper No. 11 in the above-identified application under the provisions of 37 CFR 1.144 and 37 C.F.R. 1.181. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that a restriction requirement mailed 12 February 2001, divided claims 23-44 into 12 groups of inventions, of which Groups I-IV, under traverse.

Group I, 23-37, drawn to a recombinant mammalian chromosome and cells comprising a Group I intron encoded endonuclease site (I-SceI)

Group II, 23-34, 36-37, drawn to a recombinant mammalian chromosome and cells comprising a Group I intron encoded endonuclease site (I-SceIV)

Group III, 23-34, 36-37, drawn to a recombinant mammalian chromosome and cells comprising a Group I intron encoded endonuclease site (I-CsmI)

Group IV, 23-34, 36-37, drawn to a recombinant mammalian chromosome and cells comprising a Group I intron encoded endonuclease site (I-PanI)

Groups V-XII drawn to other inventions were not traversed.

The examiner held that Groups I-IV were distinct because they were not disclosed as capable of use together and they have different modes of operations, different functions or different effects, citing MPEP 806.04 and MPEP 808.01. Further, the examiner held that the I-SceI, I-SceIV, I-CsmI and I-PanI are structurally and functionally distinct endonucleases that have structurally divergent sites of action and result in structurally distinct nucleic acid cleavages.

The examiner reasoned that Claims 23-27, 29-34 and 36-37 are generic to original Groups I-VIII because they encompass multiple inventions. Any of elected Groups I-VIII would be examined to the extent it encompassed the elected subject matter.

In Paper No 13, filed 30 March 2001, Applicants elected Group I, with traverse and cited 37 C.F.R. 1.141, alleging that the claims recite more than one species but do not exceed a reasonable number of species. Applicants also cited 37 C.F.R. 1.146, requesting that the examiner clarify the election of species, if one is required. Additionally, Applicants cited MPEP 803.02, in that it is improper for the Office to refuse to examine that which applicants regard as their invention. The Petition cited MPEP 809, which says that the linking claims must be examined with the invention elected. Applicants stated that their claims are genus claims linking species claims and that the linking claim must be examined with the species claim. Claims 23-37 were canceled and replaced by claims 45-60.

In Paper No. 14, mailed 20 June 2001, the examiner maintained and made final the restriction requirement between Groups I-VI reasoning that the genus claim encompassed patentably distinct species that are not disclosed as being capable of use together, and they have different modes of operation, different functions or different effects, citing again MPEP 806.04 and MPEP 806.01. The examiner also stated that the application was filed under 35 USC 111(a) and not under 35 USC 371, therefore the arguments drawn to the "unity of invention" were found lacking.

Claims 45-48, 50-51, 52-55 and 57-60 were withdrawn as being directed to non-elected inventions pursuant to 37 CFR 1.142(b), there being no allowable generic or linking claim. Claims 45-48, 50-51, 52-55 and 57-60 were examined to the extent that they read upon Group I, recombinant mammalian chromosome encoding an I-SceI endonuclease site.

The Office Action also a section numbered 4 that appears contain comments about, but not including, a rejection set forth under 35 USC 112, first paragraph for written description and which discusses the non-allowability of the generic claims that apparently had been withdrawn from examination.

Claims 49 and 56 were objected to as being dependent upon a withdrawn base claim, but would be allowable if rewritten independently excluding all the non-elected limitations of the base claim and any intervening claims.

DISCUSSION

The restriction requirement between Groups I-IV, set forth on 12 February 2001 as Paper No. 11 was proper. Independent Claim 23 recited a recombinant mammalian or plant chromosome comprising an endonuclease site selected from the Group consisting of HO endonucleases and Group I intron-encoded endonucleases.

The phrase "Group I intron encoded endonucleases" properly linked the patentably distinct Groups I-IV.

As stated in MPEP 809:

"Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required."

The following statement should have been included with the Restriction Requirement.

"Claims 23-34 and 36-37 link inventions I-IV. The restriction requirement among the linked inventions is subject to the non-allowance of the linking claims 23-34, 36-37. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re

Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131 - 32 (CCPA 1971). See also MPEP § 804.01."

The Examiner failed to follow the above requirements by not examining, in addition to the elected invention, the linking claims, as required by MPEP 809.

Applicants argue that their claims are genus claims linking species claims and that the linking claim must be examined with the species claim. This is not persuasive for the following reasons. The restriction requirement set forth the different chromosomes as patentably distinct groups and not in a genus/species relationship. MPEP 809.03 states that patentably distinct groups may be linked by a linking claim.

Since the endonuclease sites are patentably distinct and not in a genus/species relationship, as required by In re Weber, the linking claims should have been examined along with the elected invention. This is in keeping with the guidance of MPEP 809. Had the linking claim been found allowable, it would have been proper to withdraw the restriction requirement and examine all of the linked inventions. It was improper for the Office to refuse to examine applicants' linking claims.

DECISION

Applicants' petition is **GRANTED IN PART** for the reasons set forth above.

The application will be forwarded to the examiner for action not inconsistent with this decision.

Any request for reconsideration of this decision must be by way of a renewed petition and must be filed within TWO MONTHS of the date of mailing of this decision in order to be considered timely.

Should there be any questions with respect to this decision, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, Washington DC 20231 or by telephone at (703) 308-7553 or by facsimile transmission at (703) 305-7230.

John Doll
Director, Technology Center 1600

PLEASE NOTE:

I-SceI, I-SceIV, I-CsmI and IPanI are structurally and functionally distinct endonucleases. In addition, the encoded endonuclease site (dsDNA sequence) for each enzyme is unique. For example, I-SceI site can not be cut by I-PanI enzyme and vice versa.